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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/017,639 | 11/21/2001 | Jorg Schepers | 1999P1897 | 6397 |

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| EXAMINER | |
|---|---|
| TRAIL, ALLYSON NEEL | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2876 | |

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/017,639 | SCHEPERS, JORG | |
| | Examiner | Art Unit | |
| | Allyson N. Trail | 2876 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *27 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-3* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the Amendment filed January 27, 2005.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chidley et al (5,245,317) in view of McCabe et al (6,068,192).

Chidley et al teaches the following in regards to claims 1-3:

"A method and system are provided for monitoring an item within a defined area and sounding an alarm if the item is removed from the area." (Abstract).

"A security tag having a detector and alarm is attached to the items to be monitored within the area. Sensing circuits may be additionally provided to determine whether a security tag is being tampered with or removed by an unauthorized person. The security tag's alarm is sounded in the event that the receiver does not detect the ultrasound indicating that the monitored item is no longer in the monitored area. Additional alarms may be provided for indicating that the security tag has been tampered with or removed." (Abstract).

"Preferably, the alarm 64 is capable of providing a different audible alarm depending upon whether it is to be indicative of a theft, tampering or attempted

destruction of the security tag 14. In such an embodiment, the detectors 22 shown in FIG. 1 would be operable to distinguish the type of audible alarm and trigger additional alarms based on whether a theft was taking place." (Col. 5, lines 56-62).

Claim 5 discloses the following:

"The system of claim 4, further comprising: an alarm detector for detecting the alarm signals from the security tag and for triggering additional alarms indicative of the alarm signal so detected."

Because sensing circuits are used, it is clear that the degree of sensitivity can be chosen by the design of the sensing circuits.

Chidley et al's teachings above fail to teach the sensing system being applied to tampering with a smart card.

McCabe's teaches the following in regards to claim 1:

"The invention relates to smart cards. More particularly, the invention relates to protecting data on smart cards from access or tampering by unauthorized individuals." (Col. 1, lines 14-16).

"Radio frequency identification devices can also be considered to be smart cards if they include an integrated circuit." (Col. 1, lines 65-66).

"Various tamper detection mechanisms are in present use with respect to smart cards. However, there are problems with such tamper detection mechanisms and many card providers routinely disable the tamper detection mechanisms." (Col. 3, lines 14-18).

"One aspect of the invention provides a tamper resistant smart card comprising a housing including first and second portions; a memory; and means for erasing the memory if the first portion is separated from the second portion." (Col. 3, lines 48-51).

In McCabe et al's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to apply the sensing system taught by Chidley et al to the tamper detection method taught by McCabe et al. As taught above by McCabe et al a radio frequency tag can also qualify as a smart card. McCabe et al teaches erasing the memory on the smart card if a separation of two portions of the housing is sensed. One would be motivated to sense an action of tampering initially before completely disabling the smart card. By having two sets of sensors, the card would not be disabled unless it was truly being tampered with.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection. It is believed the Chidley et al in combination with McCabe et al teach the method for detecting an attempt at manipulatory intervention in a smart card as disclosed in the current claims.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Tognazzini (6,295,482).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**allyson.trail@uspto.gov**].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a*

*possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Allyson N. Trail
Patent Examiner
Art Unit 2876
April 17, 2005

JARED J. FUREMAN
PRIMARY EXAMINER